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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,926	01/25/2001	David S. Matthews	XXT-108	5475

7590 11/16/2005
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EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/769,926	Applicant(s) MATTHEWS ET AL.	
	Examiner Jerome Grant II	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

JEROME GRANT II
PRIMARY EXAMINER

Detailed Action

1.

Rejections Under 112 First Par.

Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

While the information section 10 is referred to, the written specification does not adequately teach the hardware, elements or specific instructions for accomplishing the third limitations of claims 17 and 19.

The written specification is inadequate to teach an automatic detection of the size of the input image. Page 9, lines 25-30 suggests that the calculation is done manually.

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The written specification does not adequately teach the 5 limitations of claim 17 and the fourth limitation of claim 19. Page, lines 15-20 of the specification suggests that the user intervenes to input data. There doesn't appear to be any automatic adjustments.

The written specification does not adequately teach reading an image document while preventing the reading of the white portions around the read image. There is inadequate disclosure. However, it appears that this limitation is well known according to applicant at col. 1, lines 30-32.

2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakata in view of the well known prior art.

With respect to claims 17 and 19, Nakata teaches an image forming method comprising: receiving an input document on a scanning device via document feeder

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500, scanning the original; receiving data regarding the size of the output document, as supported at col. 11, lines 9-43; receiving user data (input unit 403) for inputting the size of a document, see also, col. 10, lines 30-39; enlarging or reducing the input image automatically, see col. 9, lines 12-22, col. 10, lines 15-20; and reproducing the image a number of times, col. 9, lines 20-25.

What is not shown is scanning the image while not scanning the white portions around the image.

However, this limitation, according to applicant, is that it is well known in the art.

Hence, it would have been obvious as a matter of design choice to combine the document detection means, discussed in the prior art, for reading the original without the white margins or null data for the purpose of accurately detecting the size of the original.

With respect to claims 18 and 20, Nakata teaches the use of an electrophotographic image scanner, according to figure 1.

Examiner's Remarks

The examiner has reviewed applicant's comments, however, they are not persuasive to overcome the 112 first para. Rejection.

At page 4, applicant argues that page 7, lines 1-14 and page 8, lines 6-24 teach the third limitation of claim 17. However, this section of the specification does not recite, "receiving user data... comprising the number of images to be reproduced..."

Applicant states that page 4, lines 4-6 further teaches the claimed limitation. However, upon further view, this section of the specification is directed toward the Summary of the Invention. This section of the specification explains what the invention is trying to solve but it does not explain how the above claimed limitation will be realized. No structure or interactions between different structures are set forth to explain the claimed feature.

Applicant argues the fifth limitation of claim 17 is addressed at page 9, lines 7-23. However, this section of the specification does not address receiving any user input. Although it mentions dimensions of received data, there is no teaching of "...receiving user data concerning an output document, the user data comprising the number of images to be reproduced...."

Applicant asserts that the examiner does not have a motivation to combine and has not established a prima facie case of obviousness.

The examiner is combining what is known and taught by Nakata and what is known and taught by applicant's specification.

At page 7, lines 30-34, the written specification states that it is well known to copy only the image portion without the border or null data.

Hence, the examiner was using as a rationale for the rejection a statement that applicant admitted is already known in the art. Hence, applicant's own statement provides prima facie case of obviousness in view of Nakata which also takes pictures of data to be magnified or reduced. It would have been obvious for Nakata to take a picture of the original without the margins or null data as suggested by applicant.

4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II



JEROME GRANT II
PRIMARY EXAMINER